

REMARKS/ARGUMENTS

Claims 1-5, 8, 9, and 11-14 are pending in this subject application. Applicants have hereinabove amended claims 1-4, cancelled claim 11, and cancelled withdrawn claims 8, 9, 13 and 14 without prejudice. Accordingly, upon entry of this Amendment, claims 1-5 and 12, as amended, will be pending and under examination.

Applicants maintain that the amendments to the claims 1-4 do not raise any issue of new matter, and that such amendments are fully supported by the specification as originally filed.

Moreover, in making these amendments, applicants neither concede the correctness of the Examiner's objections or rejections in the July 9, 2008 Non-Final Office Action, nor abandon the right to pursue in a continuing application embodiments of the present invention no longer claimed in this application.

In view of the remarks/arguments set forth below, and amendments to the claims hereinabove, applicants submit that the Examiner's objections and rejections made in the July 9, 2008 Non-Final Office Action have been overcome and respectfully request that the Examiner reconsider and withdraw these grounds of objections and rejections.

Claim Objections

The Examiner objects to claims 1-5, 11 and 12 since these claims contain non-elected subject matter.

In response to the Examiner's objection to claim 11, but without conceding the correctness thereof, applicants point out that claim 11 has been cancelled. Therefore, this objection to claim 11 is moot.

In response to the Examiner's objection to claims 1-5 and 12, but without conceding the correctness thereof, applicants note that claims 1-5 and 12 have been amended in accordance with the Examiner's recommendation. Accordingly, the above objection is obviated.

The Examiner also objects to claim 1 since it contains at the end the phrase "...or optically pure enantiomers, mixtures of enantiomers, racemates, optically pure diastereoisomers, mixtures of diastereoisomers, diastereoisomeric racemates, mixture of diastereoisomeric racemates, or meso forms, or pharmaceutically acceptable salts thereof", and that such phrase does not allegedly agree in number with "A compound" and therefore is indefinite.

In response to the Examiner's objection to claim 1, but without conceding the correctness thereof, applicants note that claim 1 has been amended in accordance with the Examiner's recommendation. Accordingly, the above objection is obviated.

Claim Rejection Under 35 U.S.C. § 112, First Paragraph (Enablement)

The Examiner states that claims 1-3, 5, 11 and 12 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Specifically, the Examiner states that the specification, while being enabling for a compound or composition where R¹-R⁴ are hydrogen; R⁵ is hydrogen, C₁-C₅ alkyl, -(CH₂)_m-CO₂-C₁-C₅ alkyl, or -(CH₂)_m-CONH₂; R⁶ is hydrogen or alkyl; and n=0, does not reasonably provide enablement for any other compounds or compositions not previously mentioned above.

In response to the Examiner's rejection to claim 11, but without conceding the correctness thereof, applicants point out that claim 11 has been cancelled. Therefore, this rejection to claim 11 is moot.

In response to the Examiner's rejection to claims 1-3, 5 and 12, but without conceding the correctness thereof, applicants note that claims 1-3 have been amended, and respectfully traverse the Examiner's rejection.

Claim 1, as amended, recites to a compound of formula (I) wherein, among other things, R^1 , R^2 , R^3 , R^4 are hydrogen; R^5 is hydrogen, C₁-C₅ alkyl, $-(CH_2)_m-CO_2-C_1-C_5$ alkyl, $-(CH_2)_m-CONH_2$, $-(CH_2)_m-CONH-C_1-C_5$ alkyl, or $-CON-(C_1-C_5 \text{ alkyl})_2$; R^6 represents hydrogen, or C₁-C₅ alkyl; and n is the integer 0.

Applicants maintain that compounds wherein R^5 represents $(CH_2)_m-CONH-C_1-C_5$ alkyl or $-CON-(C_1-C_5 \text{ alkyl})_2$ are enabled by the specification as filed. For example, pages 11 to 14 of the specification as filed teach the manner and process of making the present invention. Additionally, Example 11 (on page 40 of the specification as filed) describes the synthesis of an intermediate acid wherein R_5 represents $-(CH_2)_m-CO_2H$, which compound is in the following transformed to the Example 11 compound where R_5 represents $-(CH_2)_m-CONH_2$ using a solution of ammonia (in dioxane) and standard amide coupling conditions (EDC-HCl; DMAP). One skilled in the art would acknowledge these conditions are well known in the art, and would understand that other well known and commercially available amines (such as $NH_2-C_1-C_5$ alkyl or $HN-(C_1-C_5 \text{ alkyl})_2$), may be used in this step.

In light of the above, and in view of Examples 10 (ester) and 11 (primary amide), one skilled in the art could make and use the present invention wherein R^5 represents -

(CH₂)_m-CONH-C₁-C₅ alkyl or -CON-(C₁-C₅ alkyl)₂ from the specification as filed coupled with information known in the art without undue experimentation.

In view of the above remarks, applicants maintain that amended claims 1-3, 5 and 12 satisfy the requirements of 35 U.S.C. § 112, first paragraph, and request that the Examiner reconsider and withdraw this ground of rejection.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph (Indefiniteness)

The Examiner states that claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as an invention. Specifically, the Examiner states that there is insufficient antecedent basis for "3-(2-Ethoxy-phenyl)-1-(4-methyl-3-oxo-3,4-dihydro-quinoxalin-2-ylmethyl)-1-((S)-2-phenyl-propyl)-urea" recited in claim 4.

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants note that claim 4 has been amended. Claim 4, as amended, does not recite "3-(2-Ethoxy-phenyl)-1-(4-methyl-3-oxo-3,4-dihydro-quinoxalin-2-ylmethyl)-1-((S)-2-phenyl-propyl)-urea." Accordingly, this rejection to claim 4 is moot.

Conclusion

In light of all of the foregoing, it is respectfully submitted that this application is now in condition to be allowed and the issuance of a Notice of Allowance is respectfully solicited.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

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Respectfully submitted,

By 

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